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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91225613
Party	Defendant AAF Nation, LLC
Correspondence Address	ANDREW D SKALE MINTZ LEVIN COHN FERRIS ET AL 3580 CARMEL MOUNTAIN RD, STE 300 SAN DIEGO, CA 92130-6768 UNITED STATES adskale@mintz.com, jddib@mintz.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Andrew D. Skale
Filer's e-mail	adskale@mintz.com, jddib@mintz.com
Signature	/Andrew D. Skale/
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Attachments	Motion to Stay - Suspend Opposition - SEMPER SILKIES.pdf(19129 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
M.J. Soffe, LLC

Opposer

v.

AAF Nation, LLC

Applicant

Opposition No. 91225613

APPLICANT AAF NATION'S LLC
MOTION TO SUSPEND OPPOSITION

AAF Nation, LLC ("AAF"), through its undersigned counsel, states as follows for its Motion to Suspend Cancellation pending the final determination of a civil action between the parties.

I. INTRODUCTION

This matter concerns M.J. Soffe, LLC (Soffe) Opposition of Application Number 86563273 for SEMPER SILKIES (the '273 Application), owned by AAF Nation, LLC ("Applicant").

Applicant is in the process of initiating a civil action against Soffe in the United States District Court for the Southern District of California regarding the SEMPER SILKIES mark (the "District Court Action").

In the District Court Action, Applicant has alleged, among other things, that it owns enforceable rights in the SEMPER SILKIES mark, that such rights are evidenced by the '273 Application and that Soffe has infringed and otherwise violated those rights.

The District Court Action thus will have a direct impact on these proceedings. In accordance with well-established principles, including those codified in 37 C.F.R. 2.117(a) and set forth in Section 510.02(a) of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), AAF respectfully requests that the Board suspend this opposition pending a final determination of the District Court Action.

II. FACTS AND PROCEDURAL HISTORY

Applicant is in the process of filing the District Court Action, in which Soffe is named as defendant. In the complaint, (the “Complaint”)¹, Applicant alleges that it owns rights in the SEMPER SILKIES mark that are superior to Soffe’s rights in SEMPER SILKIES, that Soffe’s use of the SEMPER SILKIES mark is confusingly similar to Applicant’s mark, and that Soffe has infringed Applicant’s rights.

III. ARGUMENT

When parties to a Board proceeding are involved in a civil action that may be dispositive of the issues before the Board, the Board generally will suspend its proceedings pending the final determination of the civil action. See 37 C.F.R. 2.117(a). This rule is set forth in TBMP 510.02(a), which states: “Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action.” TBMP § 510.02(a); see also *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992) (granting a motion to suspend where “[a] decision by the district court [would] be dispositive of the issues before the Board”); *Tokaido v. Honda Associates, Inc.*, 179 USPQ 861 (TTAB 1973) (suspending opposition proceeding “pending final determination of the civil suit in which the parties are now involved”).

¹ As the Complaint is being filed simultaneously with this motion, a copy of the Complaint will be provided via a supplemental filing to this motion.

The question before the Board, therefore, is whether the District Court Action will have a “bearing” on the opposition. See TBMP § 510.02(a). “Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board.” *Id.* The Complaint, Answer and Counterclaims all raise issues that are identical to those at issue in this opposition proceeding before the Board. The opposition therefore should be suspended pursuant to 37 C.F.R. 2.117(a) and TBMP § 510.02(a).

As discussed above, Applicant has alleged in the District Court Action that it owns enforceable rights in the SEMPER SILKIES mark and that Soffe’s use of the mark is confusingly similar to Applicant’s mark, and that Soffe has infringed Applicant’s rights.

These matters, as raised by Applicant in the Complaint, are central to the District Court Action. Any final determination by the District Court of the likelihood of confusion between the parties’ marks and the priority of rights would resolve the questions before the Board in this opposition. For these reasons, the District Court Action not only will have a “bearing” on the issues before the Board, but also likely will be dispositive. See *General Motors Corp.*, 22 USPQ2d 1933 (TTAB 1992) (granting a motion to suspend where “[a] decision by the district court [would] be dispositive of the issues before the Board”). Accordingly, AAF respectfully submits that the Board should grant AAF’s Motion to Suspend and, pursuant to that suspension, suspend each party’s rights or obligations to file motions, briefs, and other memoranda.

IV. CONCLUSION

For the foregoing reasons, AAF respectfully requests that the Board suspend this Opposition No. 91225613 pending a final resolution of the District Court Action and, pursuant to that suspension, suspend each party’s rights or obligations to file motions, briefs, and other memoranda.

Respectfully submitted,

By: /Andrew D. Skale/
Andrew D. Skale
Mintz, Levin, Cohn, Ferris, Glovsky, and
Popeo, P.C.
3580 Carmel Mountain Road
Ste 300
San Diego, CA. 92130
Tel: 858-314-1506
Fax: 858-314-1501
E-mail: adskale@mintz.com

Attorneys for Respondent
AAF Nation, LLC

Dated: August 12, 2016

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on August 12, 2016, a true copy of this document was served on counsel for the Applicant by delivering the same via First Class U.S. Mail, postage prepaid, to:

J. Parks Workman
Thomas D. Huycke
Dority & Manning, P.A.
Post Office Box 1449
Greenville, SC 29602-1449
Attorneys for: M.J. Soffe, LLC

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